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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,690	04/17/2001	Bernard Gilder	00216-396003 / Case 4225	7984

7590

05/02/2002

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EXAMINER

PETERSON, KENNETH E

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 05/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/836,690

Applicant(s)

GILDER ET AL.

Examiner

Kenneth E Peterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 6-12 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 6-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. 6) ☐ Other: \_\_\_\_\_

1. Applicant's election with traverse of group I in Paper No. 9 is acknowledged. The traversal is on the ground(s) that the inventions are not independent. This is not found persuasive because Applicant is arguing against an American-style restriction, when, in fact, the case was filed under 371 and therefore is subject to a lack-of-unity style restriction. In lack of Unity, the dependent claims can be separated if they each have their own special technical feature and if the independent claim is shown to be unpatentable. See 37 CFR 1.476d.

The requirement is still deemed proper and is therefore made FINAL.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1,3 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,6 and 8 of U.S. Patent No. 6,216,349. Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the subject matter of current claims 1,3 and 12 can be found in claims 1,6 and 8 of U.S. Patent No. 6,216,349.

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4. Claims 1,3 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,2 and 3 of U.S. Patent No. 6,212,777. Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the subject matter of current claims 1,3 and 12 can be found in claims 1,2 and 3 of U.S. Patent No. 6,212,777.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1,3,12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Welsh who shows a razor having a guard (e.g.19), a cap (e.g.20) and three parallel blades (line 54 of column 2).

Welsh does not set forth the specific blade exposures from Applicant's claim 1. However, on lines 31-33 of column 4, Welsh states that "*the second or follower blade can be given a greater exposure than would be desirable for the first or leading blade*". Welsh goes on to say that "*Either the leading blade or both blades may be given a negative exposure*".

Given Welsh's teaching that the leading blade could have a negative exposure, and Welsh's teaching that following blades should have a higher, non-negative exposure, and Welsh's teaching that following blades can have a positive exposure, it

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would have been obvious to one of ordinary skill in the art to have set the blade so that the first blade had a negative exposure and the third blade have a positive exposure.

More generally, Welsh teaches having a exposure differential of  $+0.003''$  between leading blades and following blades. Welsh gives examples of exposures for the leading blades of  $-0.003''$  and  $+0.003''$ , but one of ordinary skill would recognize that one could pick any exposure therebetween as a starting point. For example, for the exposure of the leading edge, one could pick  $-0.001''$ . Following Welsh's teachings, the second blade would have an exposure  $0.003''$  higher, which would be  $0.002''$ , and the third blade would have an exposure  $0.003''$  higher, which would be  $0.005''$ .

In regards to claims 3 and 12, Welsh's drawings show spans between the guard and the first and second blades that are roughly proportional to Applicant's claimed spans. If it is interpreted that Welsh's spans are not 1mm, 1.5mm, 1.5mm respectively, then it is deemed that it would have been obvious to one of ordinary skill in the art to have arrived at these numbers by routine experimentation because the specific spans do not offer unexpected results that differ in kind and not merely in degree from the spans of Welsh. In re Aller, 105 USPQ 233 (CCPA 1955).

7. Worth noting is the board decision in grandparent case 08/604,976. However, the current situation differs from the situation the board faced in two ways.

Firstly, the board reviewed a "Gilder in view of Welsh" rejection. This case is just a "Welsh" rejection.

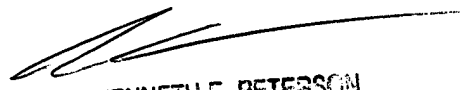
Secondly, the board reviewed a narrower claim including the parameters of exposure of the second blade.

8. Made of record but not applied are patents to Duncan, Jacobson and Burout showing razor blades with pertinent exposures.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Peterson whose telephone number is 703-308-2186. The examiner can normally be reached on Monday thru Thursday between 7am and 4pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9302. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.

kp  
April 30, 2002

  
KENNETH E. PETERSON  
PRIMARY EXAMINER